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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,320	07/18/2001	Avi Ashkenazi	10466/117	9471
9157	7590	04/20/2004	EXAMINER	
GENENTECH, INC. 1 DNA WAY SOUTH SAN FRANCISCO, CA 94080			HAMUD, FOZIA M	
			ART UNIT	PAPER NUMBER

1647

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/909,320	Applicant(s) ASHKENAZI ET AL.	
	Examiner Fozia M Hamud	Art Unit 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44, 49-52 and 54-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44, 49, 50, 51, 55, 56 is/are allowed.
- 6) ☒ Claim(s) 52 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1a. Receipt of Applicants' after final amendment and arguments filed on 20 October 2004 is acknowledged.

Status of Claims:

1b. Claims 1-43, 45-48 and 53 have been canceled. Claims 44, 49-52 and 54-56 are pending and under consideration.

2a. Upon further consideration and search, the examiner has decided to withdraw the finality of the previous office action (mailed on 17 June 2003). PROSECUTION IS HEREBY REOPENED.

3. The following previous objections and rejections are withdrawn in light of Applicants amendment filed on 02/09/04:

(I) The rejection of claims 39-46, 49-52 and 54-58 made under 35 U.S.C. 112, first paragraph, for not enabling an isolated nucleic acid encoding the polypeptide of SEQ ID NO:263 or which encodes variants of SEQ ID NO:263.

Priority:

4. The subject matter defined in claims 44, 49-52 and 54-56 is afforded the filing date of the parent Application PCT/US99/30095, filed on 16 December 1999.

Claim rejections-35 USC § 102(b):

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5a. Claims 52 and 54 are rejected under 35 U.S.C § 102(b) as being anticipated by Ricke et al. (31 December 1997).

Ricke et al discloses an isolated nucleic acid that shares 30.7% over all homology and 69% to nucleotide residues 770-1370 of the presently claimed nucleic acid of SEQ ID NO:262. See attached copies of the comparison of SEQ ID NOs:262, claimed in the instant invention and the sequences of the references (SEQUENCE COMPARISON 'A'). The nucleic acid disclosed by Ricke et al meets the "at least 10 nucleotides" limitation recited in instant claim 54. The nucleic acid disclosed by Ricke et al would also be expected to hybridize to the nucleic acid of SEQ ID NO:262, recited in instant claim 52.

Therefore the Ricke et al reference anticipates the instant claims 52 and 54 in the absence of any evidence to the contrary.

Conclusion:

4. Claims 44, 49-51 and 55-56 are allowable.

Advisory Information:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia M Hamud whose telephone number is (571) 272-0884. The examiner can normally be reached on Monday, Thursday-Friday, 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary L Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fozia Hamud
Patent Examiner
Art Unit 1647
19 April 2004


GARY KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600